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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,509	03/14/2001	Yoshitaka Dansui	L7016.01105	1885

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STEVENS, DAVIS, MILLER & MOSHER, L.L.P.
Suite 850
1615 L Street, N.W.
Washington, DC 20036

EXAMINER

WINTER, GENTLE E

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary**Application No.**

09/805,509

Applicant(s)

DANSUI ET AL.

Examiner

Gentle E. Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
 4a) Of the above claim(s) 17 is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-16 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
 5) ☐ Notice of Informal Patent Application (PTO-152)
 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Newly submitted claim 17 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
2. Invention I, drawn to a product, and invention II, drawn to a process, are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different product, namely a illuminating phosphor or a paint pigmenting component and the product as claimed can be made by another and materially different process, namely molding the material. The inventions are distinct, each from the other because of the following reasons:
3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 17 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Affidavit

Applicant has provided an affidavit, which appears differentiate the current invention from a prior art of record system. Unfortunately, the claims are not commensurate in scope with the declaration. Applicant would seemingly differentiate the claims from the

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prior art of record by modifying the claims to reflect the invention as disclosed in the declaration. At this time the claims will not be allowed.

Response to Arguments

4. Applicants submit that JP '279 fails to disclose the feature recited in claim 1 of a "rare earth compound that is produced by treating a rare earth oxide with an aqueous alkaline solution and an oxidizing agent."

5. Applicants reaffirm the view "it is clear that Yb₂O₃ was not treated with an aqueous alkaline solution and an oxidizing agent before assembling the battery. Thus, it is clear that JP '279 does not teach the feature recited in the present claims."

6. The arguments have been carefully considered and are persuasive as to claims 1 and 8 but are not persuasive as to claim 9. As such, the JP '279 based rejections, inasmuch as they relate to claims 1 and 8 are withdrawn. As to claim 9, applicant argues that the limitations from the specification are to be read into claim 9. In doing so applicant apparently relies on the applicants' right to be their own lexicographer. This is well accepted in practice and as such the argued definition of "rare earth hydroxide precursor" has become part of the claim. Applicant is respectfully requested to place the language into the claim. The rejection of claim 9 is withdrawn based on the limitation argued to be present in the claim, based on the definition provided by the specification.

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, and 6-16 are rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent No. 6,576,368 to Ogasawara et al. Hereinafter '368. Claims 1-3, 6-16 and the '368 reference disclose a nickel positive electrode active material comprising nickel hydroxide particles and at least one rare earth compound, the at least one rare earth compound having characteristics produced by treating a rare earth oxide with an aqueous alkaline solution and an oxidizing agent. The '368 reference discloses the claim limitations by disclosing the manufacture of a positive active material, obtainable by combining nickel hydroxide with yttrium oxide, wherein the yttrium oxide is treated with an aqueous solution of sodium hydroxide (claim 6) and an aqueous sodium hypochlorite (claim 7) oxidizing solution. Column 5, lines 13-63.

3. As to claim 3, disclosing an yttrium content of 3% with respect to the amount of nickel hydroxide, this meets the claim limitations of 0.1 to 4% based on nickel hydroxide particles. See column 5, line 59 *et seq.*

4. As to claim 8, disclosing that the above system includes a negative electrode and a hydrogen absorbing alloy and a separator. Column 3, line 65 *et seq.* Disclosing that the sealed alkaline storage battery of the present invention includes the positive electrode of the present invention, a negative electrode and a hydrogen storage alloy electrode. The

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separator is inherent in every battery, and is disclosed at column 6, line 7 *et seq.* “a separator made of polyamide nonwoven fabric.”

5. As to claims 11-16, disclosing the disordered crystalline structure, since the same method is used the same result, of necessity will follow.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over ‘368 as discussed above in view of United States Patent No. 6,136,473 Furukawa et al. Hereinafter Furukawa.

2. With specific respect to claims 4 and 5, further limiting claim 2, and disclosing that the rare earth compound is a combination of the yttrium/ytterbium compound and the lutetium compound, wherein the two compounds meet $50 \geq X \geq 5$, when weights of the yttrium compound and the lutetium compound are $(100-X) \%$ by weight and $X \%$ by weight, respectively. Each and every limitation of claim 4 is disclosed in ‘368 as set forth above, except that the ‘368 reference fails to explicitly disclose that the rare earth combination is yttrium-lutetium compound and ytterbium-lutetium compound. Wherein the two compounds (Y/Yb-Lu) meet $50 \geq X \geq 5$, when weights of the yttrium (or ytterbium) compound and the lutetium compound are $(100-X) \%$ by weight and $X \%$ by weight, respectively. Furukawa discloses that two or more kinds of selected rare earth

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elements are ytterbium and lutetium, and a ratio of the content of ytterbium to the contents of ytterbium and lutetium is larger than or equal to 0.75 when converted to an amount of oxide. See e.g. column 5, line 44 *et seq.* also see e.g. column 28, lines 5-10. Ytterbium is disclosed as a specific example of a rare earth, Y, is also disclosed as a desirable rare earth. The artisan would have been motivated to make the instant combination for the reason explicitly disclosed in Furukawa, namely, a composite compound having Yb and Lu as its principal component, for example, is inexpensive because it is formed as an eutectoid when separating and forming the rare earth element from ore. See e.g. column 5, line 51 *et seq.* Additionally the artisan would have been motivated to make the combination because Y, Ho, Er, Tm, Yb and Lu etc. have an effect of shifting the oxygen evolution potential to a more noble potential, thus reducing the likelihood of gas evolution during overcharging. See also column 25, line 48-54, disclosing Yb and Lu and optionally Y.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gentle E. Winter whose telephone number is (703) 305-3403. The examiner can normally be reached on Monday-Friday 7:00-3:30.

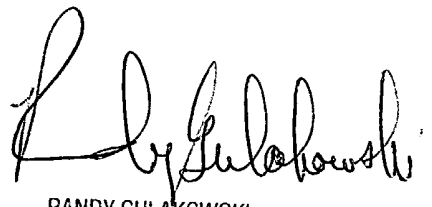
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (703) 308-4333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. The direct fax number for this examiner is (703) 746-7746.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Gentle E. Winter
Examiner
Art Unit 1746

June 15, 2004



RANDY GULAKOWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700